

Remarks

The Office Action mailed April 4, 2007 has been carefully reviewed and the foregoing amendment has been made in consequence thereof.

Applicants believe that no extension of term is required and that no additional fee for claims is required. If any additional fee is required for an extension of term or claims, the Commissioner is hereby authorized to charge Deposit Account No. 01-2384.

Claims 1-16 and 20-21 are now pending in this application. Claims 1, 10, 13, 16, and 21 have been amended. Claims 17-19 are canceled to advance prosecution and claims 22-31 are directed to a non-elected invention and are canceled herein without prejudice or disclaimer. It is respectfully submitted that the pending claims define allowable subject matter.

Claims 10, 16, and 21 have been amended to correct typographical errors. Claims 1 and 13 have been amended for clarity in response to Examiner's remarks. Claim 1 has been amended to more clearly recite a dual-use product package for packaging a non-food product at a point of sale of the non-food product that is also designed to transport food products that are not for sale once the non-food product is removed. Claim 13 has been amended to emphasize that the scope of claim 13 is limited to a footwear package for the sale of footwear, in contrast to the activity bag of the cited art.

The rejection of claims 1-21 under 35 U.S.C. § 102(b) as being anticipated by Franco et al. (U.S. Patent No. 4,506,769) is respectfully traversed.

Applicants note the following with respect to the applicable law of anticipation. As explained by the Federal Circuit, a Section 102(b) rejection on the ground of "anticipation" requires a disclosure in a single piece of prior art of each and every limitation of a claimed invention. A finding of anticipation requires that the publication describe all of the elements of the claims arranged as in the patented device. In other words, to anticipate, a single reference must teach every limitation of the claimed invention.

It is also noted that the Examiner fails to give weight to certain language of the claims, while also asserting a broad view of the cited art that is silent with respect to features clearly claimed. This is not believed to be consonant with the provisions of Section 102. It is Applicants' position that the present Office Action reflects both an unreasonably broad construction of the claims, as well as of the cited art.

Franco et al. describe an activity bag system that includes an outer carrying bag (10), multiple interchangeable inner containers (12) shaped to fit in a close-fitting relationship within one section of the outer bag (10), and a combination container storage cover/partition (14). Franco et al. provide specific examples of uses for the interchangeable inner containers (12). Franco et al. describe a first inner container (12a) containing the necessary articles for soccer, including a ball, shoes, and shin guards. Franco et al. describe a second inner container (12b) containing necessary articles for equestrian activities. And Franco et al. describe a third inner container (12c) containing the necessary articles for tennis with shoes and tennis balls shown. Each inner container (12a, 12b, 12c) is described as being surrounded by a storage cover (14). Outer bag (10) is sized to hold each inner container (12a, 12b, 12c) within a lower container-receiving section (20). A lid section (18) is separable from the lower section (20) along three sides of the bag and the two sections are hinged together along the fourth side at an integral fabric hinge (22). Closure means in the form of zippers (24) are provided along the parting edges of the three separable sides of the bag to fasten the lid and lower sections together in a closed position for carrying the contents of the bag.

Claim 1 recites a "dual-use product package comprising a non-food product; a non-rigid base defining a cavity for packaging said non-food product at a point of sale of said non-food product, said cavity designed to transport food products that are not for sale once the non-food product is removed from said cavity; a cover configured to close said cavity; and a closure member fastening said cover to said base."

It is asserted in the instant Office Action that claim 1 includes recitations of intended use that do not patentably distinguish the claimed invention from the prior art. It is further asserted in the instant Office Action that "a recitation of the intended use of the claimed invention must

result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.” Applicants respectfully submit that to the extent that it can be supported at law, this statement is improperly applied in this Office Action.

The Federal Circuit has stated that, “[i]f a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claim.” In re Schreiber, 128 F.3d 1473 (Fed Cir. 1997). However, not only the preamble of claim 1, but also the body of claim 1, includes functional recitations that distinguish claim 1 from Franco et al. It is well established that a patent applicant is free to recite features of an apparatus either structurally or functionally. In re Schreiber, 44 USPQ2d 1429, 1432 (Fed. Cir. 1997); In re Swineheart, 169 USPQ 226, 228 (CCPA 1971). In construing a patent claim for examination, it is improper to ignore functional recitations. Pac-Tec, Inc. v. Amerace Corp., 14 USPQ2d 1871, 1876 (Fed. Cir. 1990); In re Venezia, 189 USPQ 149 (CCPA 1976). In a proper construction of the claims, all recitations of the claims must be considered. See MPEP § 2143.03 (all words in a claim must be considered in judging the patentability of the claim against the prior art). Franco et al. do not describe or suggest a cavity for packaging a non-food product at a point of sale of the non-food product. Rather, in contrast to the recitations of claim 1, Franco et al. describe an activity bag system that presumably is empty at a point of sale of the activity bag system. Furthermore, Franco et al. do not describe or suggest a cavity designed to transport food products, which are not for sale, once the non-food product is removed from the cavity. Rather, in contrast to the recitations of claim 1, Franco et al. only describe an outside storage pocket for carrying a container of liquid, and do not describe any other food products.

Eventhough Applicants’ submit that the language within the body of claim 1 distinguishes claim 1 from Franco et al., Applicants’ also submit that the recitations of the preamble of claim 1 further distinguish claim 1 from Franco et al. As quoted above, the Federal Circuit has stated that, “[i]f a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claim.” In re Schreiber, 128 F.3d 1473 (Fed Cir. 1997).

However, the Federal Circuit has also stated that “a preamble may provide context for claim construction, particularly, where . . . that preamble’s statement of intended use forms the basis for distinguishing the prior art in the patent’s prosecution history.” Metabolite Labs., Inc. v. Corp. of Am. Holdings, 370 F.3d 1354, 1358-62 (Fed. Cir. 2004).

The Federal Circuit has also found that the preamble is regarded as limiting if it is important to the invention or necessary to give meaning to the claim. NTP, Inc. v. Research In Motion, Ltd., 418 F.3d 1282, 1305-06 (Fed. Cir. 2005), cert. denied, 74 U.S.L.W. 3421 (U.S. Jan. 23, 2006); SanDisk Corp. v. Memorex Prods., Inc., 415 F.3d 1278, 1284 n.2 (Fed. Cir. 2005), cert. denied, 126 S. Ct. 829 (2005). That is, if the claim drafter “chooses to use both the preamble and the body to define the subject matter of the claimed invention, the invention so defined, and not some other, is the one the patent protects.” Bell Commc'ns Research, Inc. v. Vitalink Commc'ns Corp., 55 F.3d 615, 620 (Fed. Cir. 1995). Applicants’ stated the following in the first full paragraph on page 11 of the previous Amendment,

Applicants submit that the preamble of claim 1 should be regarded as limiting. Applicants have chosen to define the subject matter of the claimed invention using both the preamble and the body of claim 1. Applicants claim a “dual-use product package” to be sold containing a product and not an “activity bag” sold solely for its use as an activity bag.

Applicants submit that this statement clearly places in the prosecution history Applicants’ reliance on the preamble to distinguish the claimed invention from the cited art and therefore, it is not proper to ignore the language of the preamble on the present record.

Accordingly, Applicants once again submit that Franco et al. do not disclose that any of the outer bag (10), the inner containers (12a, 12b, 12c), or storage cover (14) are “product packages” as is recited in claim 1. Specifically, claim 1 recites, “a non-rigid base defining a cavity for packaging said non-food product at a point of sale of said non-food product. . . .” None of the outer bag (10), the inner containers (12a, 12b, 12c), or storage cover (14) are described as defining a cavity for packaging any products at a point of sale. Presumably, and Franco et al. do not describe differently, when the activity bag system of Franco et al. is purchased, it does not include any products within it. It is likely that when purchased, the

activity bag system itself is contained within some sort of product packaging. That product packaging may include a cardboard box surrounding the activity bag system that provides surfaces with which indicia describing the features of the activity bag system may be placed. Also, this cardboard box would likely be discarded by a purchaser of the activity bag system because the product package is not designed to have a significant secondary use other than to protect the activity bag system during transit and to add to the marketability of the activity bag system through printed indicia.

Furthermore, Franco et al. do not disclose that either outer bag (10) or the inner containers (12a, 12b, 12c) are designed to transport food products that are not for sale once the non-food product is removed from the cavity, as is recited in claim 1. Franco et al. mention food or beverage at col. 4, lines 46-49, where an insulated pocket (41) for carrying a bottle or other container of hot or cold liquid is described, however, the insulated pocket (41) is in no way analogous to the cavity recited in claim 1. As shown in Figures 1 and 3, the insulated pocket (41) is external to the outer bag (10) and the inner containers (12a, 12b, 12c), whereas claim 1 recites, "said cavity designed to transport food products once the non-food product is removed from said cavity. . . ."

For at least the reasons set forth above, claim 1 is not anticipated by Franco et al.

Claims 2-12 depend from claim 1, and when the dependent claims 2-12 are considered in combination with claim 1, claims 2-12 are likewise submitted to be patentable over Franco et al.

Claim 13 recites a "footwear package for the sale of footwear, said footwear package comprising: a support surface; a plurality of soft side walls extending from said support surface and defining a cavity for holding the footwear for sale above said support surface, wherein at least one of said side walls comprises a flap folded over the remaining side walls to define a cover over said cavity; and a zipper selectively coupling and uncoupling said flap and said remaining side walls to pack and unpack the footwear for sale in said cavity."

Applicants' respectfully submit that for reasons similar to those stated above in regard to claim 1, claim 13 is likewise submitted to be patentable over Franco et al. More specifically,

Franco et al. do not describe or suggest a footwear package for the sale of footwear that includes a cavity for holding the footwear for sale above a support surface and also includes a zipper to selectively couple and uncouple a flap to pack and unpack the footwear for sale in the cavity. Rather, in contrast to the recitations of claim 13, Franco et al. describe an activity bag system that is not described as holding anything for sale. Applicants submit that it is improper for the Examiner to ignore recitations included in claim 13.

Applicants' further assert that when the limitations in the body of the claim "rely upon and derive antecedent basis from the preamble, then the preamble may act as a necessary component of the claimed invention." Eaton Corp. v. Rockwell Int'l Corp., 323 F.3d 1332, 1339 (Fed. Cir. 2003). Limitations within the body of claim 13 derive antecedent basis from the preamble. Therefore, the preamble of claim 13, in combination with the body of claim 13, recite a footwear package for the sale of footwear, the footwear package including a cavity for holding the footwear for sale.

Additionally, Applicants' stated the following in the second full paragraph on page 11 of the previous Amendment,

Applicants submit that the preamble of claim 13 should be regarded as limiting. Applicants have chosen to define the subject matter of the claimed invention using both the preamble and the body of claim 13. Applicants claim a "footwear package" to be sold containing footwear at the time of purchase and not an "activity bag" sold solely for its use as an activity bag.

Applicants submit that this statement clearly places in the prosecution history Applicants' reliance on the preamble to distinguish the claimed invention from the prior art and therefore, it is not proper to ignore the language of the preamble on the present record.

Accordingly, Applicants once again submit that Franco et al. do not disclose that any of the outer bag (10), the inner containers (12a, 12b, 12c), or storage cover (14) are a "footwear package" as is recited in claim 13. Specifically, claim 13 recites, "a footwear package for the sale of footwear, said footwear package comprising . . . a plurality of soft side walls extending from the support surface and defining a cavity for holding the footwear for sale above the support surface. . . ." None of the outer bag (10), the inner containers (12a, 12b, 12c), or storage

cover (14) are described as defining a cavity for holding footwear for sale above the support surface. Presumably, and Franco et al. do not describe differently, when the activity bag system of Franco et al. is purchased, it does not include footwear. It is likely that when purchased, the activity bag system itself is contained within some-sort of product packaging. That product packaging may include a cardboard box surrounding the activity bag system that provides surfaces with which indicia describing the features of the activity bag system may be placed. Furthermore, this cardboard box would likely be discarded by a purchaser of the activity bag system because the product package is not designed to have a significant secondary use other than to protect the activity bag system during transit and to add to the marketability of the activity bag system through printed indicia.

For at least the reasons set forth above, claim 13 is not anticipated by Franco et al.

Claims 14-16 and 20-21 depend from claim 13, and when the dependent claims 14-16 and 20-21 are considered in combination with claim 13, claims 14-16 and 20-21 are likewise submitted to be patentable over Franco et al.

Applicants therefore respectfully request that the Section 102 rejection of claims 1-21 be withdrawn.

In view of the foregoing amendments and remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,



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